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10/529,328	03/25/2005	Stephen Britton	BRI0007U	8653

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EXAMINER

WEINSTEIN, LEONARD J

ART UNIT	PAPER NUMBER
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3746

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,328	Applicant(s) BRITTON, STEPHEN	
	Examiner LEONARD J. WEINSTEIN	Art Unit 3746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment of September 25, 2008. In making the below rejections and/or objections the examiner has considered and addressed each of the applicant's arguments.

2. The examiner acknowledges the amendments to claims 1, 3, 9, 12, and 13.

Drawings

3. The drawings were received on September 25, 2008. These drawings are accepted and the examiner wishes to congratulate the applicant in overcoming the apparently serious impediment presented by the task of changing "72" to "12" in a single drawing.

Specification

4. The disclosure is objected to because of the following informalities: element 11 is referred as both a diesel engine and a diesel motor.

5. The examiner also notes that the specification discloses both a gearbox with and outlet passage (not shown) and a sump for receiving and dispensing oil. As best understood by the examiner the disclosure teaches that the outlet passage provides a path for oil that is splashed by the movement of gears to other parts of the gearbox. It is important that the specification include an express disclosure that the oil in the gearbox is in a closed circuit and never is permitted to leave a housing of the gearbox. The disclosure tends to suggest that the sump is a component of the instant invention that delivers oil to a gearbox. One of ordinary skill in the art may come to this conclusion but the absence of an express disclosure of this feature would present an issue and qualify

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as new matter since there would also need to be an express disclosure of an oil inlet.

Without an express disclosure of an oil inlet for the gearbox, the gearbox would eventually run out of oil, however this element would be considered to be new matter.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1, 4, 7-9, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saxe et al US 1,840,257 in view of Randolph US 4,676,352. Saxe teaches all the limitations as claimed for a self powered pump including: **[claim 1]** a frame 5 which supports a mounting plate 40, a engine/motor (housed in element 6) that is mounted above the plate 40 and an output shaft 34 (via a pulley system) driving a centrifugal water pump 10 whose axis of rotation is horizontal; **[claim 4]**: a mounting

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plate 40 further comprises a rear facing cut-out portion 39 for accommodating the water pump 10.

Saxe fails to teach the following limitations that are taught by Randolph including:

[claim 1] a pump (col. 1ll. 31-35) driven by a motor 2 having a vertical axis of rotation, as shown in figures 1 and 3, (examiner is referring to the motor of Randolph since it is the prime mover and the engine is for backup use), a 90 degree gear box 11 that is driven by motor 2, an output shaft 61 of the 90 degree gear box 11 driving a pump (col. 1ll. 31-35) whose axis of rotation is horizontal; **[claim 7]** gear box 11 being a step-up type. **[claim 8]** a gear box 11 and pump (col. 1 ll. 31-35) share a common shaft 51 which passes between them; **[claim 9]** a common shaft 51 passes between the pump (col. 1 ll. 31-35) and gear box 11, one end of the shaft 51 having mounted on it a first spiral bevel gear 68 having a hub, the gear box 11 supporting the hub 27 in a bearing 68; **[claim 12]** a gear box 11 end of the common shaft 51 is also supported by a tapered roller bearing 28, a main housing of the gearbox 11 having affixed to it a second mounting plate 75 which includes a well, space under plate element 75 accommodating oil tube element 135, for receiving a vertical thrust bearing 26 and 27; **[claim 13]** a well, space under plate element 75 accommodating oil tube element 135, also retains a radial thrust bearing, elements 110 and 111 via element 85 and 91 **[claim 14]** and the vertical thrust bearing, elements 26 and 27, supports a thrust collar 91 which is integral with the shaft 51. Randolph teaches that the configuration including a pump having a horizontal axis of rotation driven by a motor having a vertical axis of rotation by a series of gears intermeshed allows for a pump to be driven by multiple sources. This provides

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for pump that has a primary and backup source for a drive input. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify a mobile pump as taught by Saxe, to have drive inputs from both an engine and a separate motor having perpendicular axis's of rotation in order to provide a primary and backup means for pumping a fluid (col. 2 ll. 21-46).

9. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saxe et al US 1,840,257 in view of Randolph US 4,676,352, as applied to claim 1 above, further in view of Lucchi US 2002/0131872. A combination of the references as discussed teaches the limitations including (with reference to Saxe): **[claim 2]** a frame 5 comprises a pair of side rails (fig. 1) located below a mounting plate 40 and inclined uprights, vertical rods extending down from the a handle bar connected the frame/rails 5 via axles, which are attached to the side rails 5, and the side rails 5 supporting a pair or wheels, as shown in figure 1; **[claim 3]** and side rails 5 mounted on a lower surface of each of a stabilizing rail, with rail supporting the back side of pump 10 and element 6. A combination of the references fails to teach the following limitation that is taught by Lucchi for a portable pump with uprights 11 supporting an instrument panel 12. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify of the uprights of a portable pump, as taught by Saxe, modified to have a vertical motor driving a pump through a gear box, as taught by Randolph, to have an instrument panel or a switch for turning on the power to the pump as taught by Lucchi, in order to provide a convenient means for controlling the portable pump (Lucchi - ¶ 0019).

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10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saxe et al US 1,840,257 in view of Randolph US 4,676,352, as applied to claim 9 above, further in view of Kobenson US 2001/0021351. A combination of the references teaches the invention including (with reference to Randolph) an input shaft 61 of the gear box 11 carries another spiral bevel gear 67 which meshes with the first spiral bevel gear 68, the rotation of the bevel gears (67,68). A combination of the references fails to teach the following limitation that is taught by Randolph for a gear box 1 wherein the rotation of a two bevel gears (3, 6) creates an oil spray which enters an outlet opening, via element 15, and which is delivered from that opening to other parts of a gear box 1 (Kobenson - ¶ 0017). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a gear box with an oil spray outlet path as taught by Kobenson for a gear box as taught by Randolph, incorporated into a modification to provide a vertical motor driving a pump of portable pump, as taught by Saxe, in order to lubricate components within the gear box/ gear pump (Kobenson - claim 2 and ¶ 0017).

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saxe et al US 1,840,257 in view of Randolph US 4,676,352, as applied to claim 1 above, further in view of Mishima et al. US 6,012,956. A combination of the references teaches the invention as discussed but fails to teach the limitations taught by Mishima including a portion of an output pump diverted, via element 69, to an engine 2. It would have been obvious to one having ordinary skill in the art to add a pump output passage to an engine or motor driving the engine as taught by Mshima to a portable pump, as taught by Saxe, modified to have a vertical motor driving a pump through a gear box, as taught

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by Randolph, in order to provide a cooling means for an engine (Mishima – col. 1 ll. 17-24).

Allowable Subject Matter

12. Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

13. Applicant's arguments filed September 25, 2008 have been fully considered but they are not persuasive.

14. With respect to the examiner's **objection** to the specification the applicant asserts that the disclosure of the instant invention includes an abundance of information that would enable one ordinary skill in the art to make and use the invention.

a. The applicant argues that the examiner has provided no legal or technical basis for the **objection**. The examiner must point out that only an objection was made and not a rejection. The examiner did not make any type of rejection purposefully since no elements were claimed that were directed toward a supply of oil to a gearbox. The examiner notes that the applicant's remarks are adversarial, not objective, and wholly ineffective in addressing the examiner's objection. The examiner notes that the applicant broadly claims that the disclosure includes abundance of information but points to no specific section to address the examiner's objection. The applicant is invited to in the very least

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explain why an additional disclosure addressing how a gearbox is supplied with oil would be unnecessary by specific reference to sections of the disclosure.

b. The applicant states that the examiner's understanding of the instant application is flawed and one of ordinary skill in the art would not believe that a gearbox would at some point run out of oil in light of the examiner's point that a supply for oil to the gearbox has not been disclosed. It seems extraordinary that anyone would not find it possible that a vessel, let alone a gear box, that includes an inlet and outlet but lacks a means for supplying more fluid could find it unfathomable that a vessel could run out of said fluid. The examiner is merely attempting to determine how and if the instant invention will work after a prolonged period of time in which the initial amount of oil that was in the gearbox has been dispersed through the action of the gears and the outlet disclosed.

c. The applicant asserts that if the examiner maintains this **objection** the examiner may not make the instant office action final. The examiner did not present a rejection based on the specification therefore the argument that the examiner can make this action final is misplaced.

15. Applicant's arguments filed September 25, 2008, with regards to the rejection of claims 1, 4, 7-9, and 12-14 under 35 U.S.C. §103(a) as being unpatentable over Saxe et al. US 1,840,257 in view of Randolph US 4,676,352, have been fully considered but they are not persuasive.

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a. The applicant argues that Saxe fails to teach a mounting plate, a water cooled diesel engine, a vertical shaft and a rear facing cutout out in a mounting plate.

i. In response to the applicant's argument that Saxe fails to teach a mounting plate the examiner disagrees. The examiner notes that the limitations as claimed are sufficiently broad to encompass any teaching of an at least partially flat device, object, or mechanism, that is used for or capable of being used for supporting another object. Saxe teaches a cylinder block 40 carried by a frame and consisting of rectangular surface having a length greater than a thickness and lying horizontally to support extensions 39 that are used to mount a casing 9 for pump (Saxe – pg. 2 ll. 92-97). The block 40 therefore is a sufficient teaching for a flat/plate structure that is used for mounting.

ii. The applicant argues Saxe fails to teach a marine grade water cooled engine mounted above a mounting plate. The examiner notes that Saxe teaches an engine that may be “of any generally familiar type” (Saxe – pg. 28-30). At the time of the invention of Saxe, water cooled diesel engines were known in the art as evidenced by Scott US 1,812,834 (which incidentally teaches a water cooled engine mount on a frame/rail structure). The examiner is not providing a new ground for rejection in this section but is establishing that a teaching of a water cooled diesel engine was well within the scope of statement in Saxe at the time of that

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invention. However the examiner notes that a recitation of an engine, of any type, which has a shaft extending there from it in order to drive a pump, is sufficient to teach the limitations as claimed. Claim 1 does not present any limitation directed toward a specific interaction between a marine water cooled diesel engine and any of the remaining components claimed that would render the combination of a marine water cooled diesel engine with a pump to be nonobvious over any other combination using a different type engine to drive a pump.

iii. The applicant argues that Saxe fails to teach an engine with vertical shaft. The examiner notes that Saxe was not relied upon to teach a vertical shaft.

iv. With respect to claim 4, the applicant argues that Saxe fails to teach a mounting plate having a cutout. The examiner notes that the limitations as claimed are sufficiently broad so to encompass a mounting plate has some type of void in it. Element 40 is a cylinder block carries wedge shaped sliding block that includes a void between the mounting extensions of element 39 and therefore teaches the claimed limitations.

b. The applicant argues that there would be no reason to combine Saxe et al. US 1,840,257 and Randolph US 4,676,352. The examiner disagrees and maintains that Randolph teaches that the configuration including a pump having a horizontal axis of rotation driven by a motor having a vertical axis of rotation by a series of gears intermeshed allows for a pump to be driven by multiple sources.

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Providing a dual or a redundant source of power to a working machine enables the working machine to be driven by a secondary power source while a primary source is replaced or serviced. This provides the benefit of constant operation of the working machine with no down time even while maintenance is required by one component of the assembly. Therefore Randolph provides a sufficient motivation for the combination of the rejection.

16. Applicant's general arguments filed September 25, 2008, with regards to the rejection of claims 2-3 under 35 U.S.C. §103(a) as being unpatentable over Saxe et al. US 1,840,257 in view of Randolph US 4,676,352, as applied claim 1, further in view of Lucchi US 2002/0131872, the rejection of claim 10 under 35 U.S.C. §103(a) as being unpatentable over US 1,840,257 in view of Randolph US 4,676,352, as applied to claim 9, further in view of Kobenson US 2001/0021351, and the rejection of claim 11 under 35 U.S.C. §103(a) as being unpatentable over Saxe et al US 1,840,257 in view of Randolph US 4,676,352, as applied to claim 1, further in view of Mishima et al. US 6,012,956, have been fully considered but they are not persuasive.

a. With respect to the rejections state above the applicant argues that the examiner has engaged "in speculation, fanciful interpretation of the technical content of the are and hindsight reconstruction." No matter the level of disagreement the examiner may with this assertion, the applicant has presented only a blanket statement for an argument. The applicant fails to specifically point out either the of elements which the secondary references do not teach or why one ordinary skill in the art would not have found it obvious to make the

respective combinations suggested. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

17. The examiner notes the mention by the applicant of examiner's constitutional duties on page 3 of the response. The examiner finds it necessary to inform the applicant that the examiner views these duties in terms of a collaborative effort between the examiner and the applicant to produce the best patent and not a set of tenants that are begrudgingly followed in what the applicant appears to view as the sporting fair of prosecution. The examiner encourages the applicant to contact the examiner if the applicant deems further clarification may be needed in order to be convinced that the full scope of instant application is fully understood by the examiner.

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEONARD J. WEINSTEIN whose telephone number is (571)272-9961. The examiner can normally be reached on Monday - Thursday 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on (571) 272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Devon C Kramer/
Supervisory Patent Examiner, Art
Unit 3746

/Leonard J Weinstein/
Examiner, Art Unit 3746